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REMARKS

Claims 1-20 remain pending.

In the Office Action, the Examiner rejected claims 1-5 and 16-20 under 35 U.S.C. § 101; and rejected claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over Nelson et al. (U.S. Publication No. 2004/0236830 A1) in view of King et al. (U.S. Patent No. 5,600,775).

§ 101 Rejection:

Regarding the § 101 rejection, Applicants do not acquiesce to the Examiner's interpretation of the claims as "software per se, abstracts [sic] ideas, or mental construct." Claims 1-5 and 16-20 recite a process, and claims 12-15 recite an article of manufacture, both of which are presumptively statutory. As far as Applicants can tell, the rejection on page 2 of the Office Action appears to be (i.e., "fail to set forth physical structures or materials comprising of hardware or a combination of hardware and software" on page 2 of the Office Action, 4 and 5 lines from bottom) a "machine implemented test." This is not a proper test for subject matter eligibility. See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility (22 November 2005), Annex III "Improper Tests For Subject Matter Eligibility," section d) "Machine Implemented Test": "a finding that a claim fails to recite a computer-implemented process is not determinative in whether that claim passes muster under Sec. 101." Thus, Applicants traverse the § 101 rejection, because it is based on an improper test.

For completeness, Applicants note the following. Claims 1-5 as a whole are useful and produce at least the practical result of an index of media information that has been modified to reflect the presence of stored annotation information. Claims 12-15 as a whole are useful and when executed by a computing platform produce at least the practical result of combining media information and annotation information to display annotated media information. Claims 16-20 as a whole are useful and produce at least the practical result of modifying an index file associated with media information at the point at which an annotation request was received to reference stored annotation information. Annotating media information is decidedly useful and practical and to characterize any of these claims, as a whole, as "abstract ideas" is improper.

§ 103 Rejection:

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Initially, Applicants note that no element of independent claims 1, 7, 12, and 16 has been read on a particular component of Nelson et al. or King et al. Instead, the Summary sections and other large contiguous portions (e.g., paragraphs 0008 to 0055 on page 6 of the Office Action) of these references are cited, without further text-based explanation or elaboration. This amounts to an unsupported, general allegation that "It's in there somewhere."

This does not meet the Examiner's evidentiary burden of establishing a *prima facie* case of obviousness. Such general citation also forces Applicants to guess at exactly which components of Nelson et al. and King et al. the Examiner considers to teach or suggest the claimed limitations. Applicants respectfully reminds the Examiner that under 37 C.F.R. § 104(c)(2) "the particular part [of the reference] relied on must be designated as nearly as practicable," and respectfully requests that, in any subsequent actions containing art rejections, *all claim limitations* be read upon "particular part[s]" of the reference(s).

As an evidentiary and legal matter, the Office Action is insufficient on its face to establish a *prima facie* case of obviousness, as explained above. Nonetheless, in an effort to advance prosecution, Applicants note the following.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

A *prima facie* case of obviousness has not been established for claims 1-6 at least because the references as combined fail to teach or suggest all the claim limitations. Claims 1-6 require a method including, *inter alia*, "modifying an index of the media information to reflect a presence of the annotation information." Nelson et al. and King et al. fail to teach or suggest at least this limitation.

Page 5, lines 1-4, of the Office Action admits that Nelson et al. does not teach this, but alleges that col. 2, line 1 through col. 3, line 30 of King et al. "provides an indexing scheme

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[that] relates the annotations to the video frames." That is not what is claimed. Again, claims 1-6 require "modifying an index of the media information to reflect a presence of the annotation information." King et al. does not teach or suggest modifying an index of media information, as claimed.

Instead, King et al. provides at col. 2, lines 17-31 (with emphasis added):

The method includes displaying the file of indexed data structures using a file display routine, and selecting in response to user input an indexed data structure to be annotated from the file of indexed data structures being displayed. Next, **an annotation data structure is created in response to user input using an annotation routine without modifying the selected data structure.** The annotation data structure includes a graphical element for display overlaying the selected data structure and an indication of an index value for the selected data structure. **The annotation data structure is stored in an annotation file apart from the file of indexed data structures.** During playback, the annotation file is monitored to detect annotation data structures for indexed data structures currently being displayed.

The cited portion of King et al. teaches creating and monitoring a separate annotation data structure; it does not teach or suggest "modifying an index of media information," as set forth in claims 1-6. Thus, a *prima facie* case of obviousness has not been established for claims 1-6, and the 35 U.S.C. § 103(a) rejection should be withdrawn.

A *prima facie* case of obviousness has not been established for claims 7-11 at least because the references as combined fail to teach or suggest all the claim limitations. Claims 7-11 require an apparatus including, *inter alia*, "a memory to store . . . index information relating to the annotation information and the media information; and a processor . . . to selectively retrieve the annotation information from the memory based on the index information." Nelson et al. and King et al. fail to teach or suggest at least this limitation.

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As explained above, King et al. fails to teach or suggest “index information relating to the annotation information and the media information” as claimed. The annotation data structure and the indexed data structures do not share an index.

Nelson et al. also fails to teach or suggest “index information relating to the annotation information and the media information” and a “processor . . . to selectively retrieve the annotation information from the memory based on the index information” as claimed. In any event, page 6 of the Office Action fails to specifically show where this is allegedly found in Nelson et al., and does not provide sufficient evidence for a *prima facie* showing. Thus, a *prima facie* case of obviousness has not been established for claims 7-11, and the 35 U.S.C. § 103(a) rejection should be withdrawn.

A *prima facie* case of obviousness has not been established for claims 12-15 at least because the references as combined fail to teach or suggest all the claim limitations. Claims 12-15 require an article of manufacture including, *inter alia*, “outputting stored media information based on an index file associated with the media information; and detecting an annotation marker in the index file.” Nelson et al. and King et al. fail to teach or suggest at least this limitation.

As explained above, neither Nelson et al. nor King et al. teaches or suggests “detecting an annotation marker in the index file” that is “associated with the media information” as claimed. The quoted portion of King et al. above explicitly discloses that the indexed data structures do not include annotation markers. See again from that portion of King et al., “an annotation data structure is created . . . without modifying the selected data structure. . . . During playback, the annotation file is monitored to detect annotation data structures.”

Nelson et al. also fails to teach or suggest detecting an annotation marker in an index file that is associated with the media information, as set forth in claims 12-15. Thus, a *prima facie* case of obviousness has not been established for claims 12-15, and the 35 U.S.C. § 103(a) rejection should be withdrawn.

A *prima facie* case of obviousness has not been established for claims 16-20 at least because the references as combined fail to teach or suggest all the claim limitations. Claims 16-20 require a method including, *inter alia*, “outputting stored media information based on an

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associated index file; and modifying the index file at the point at which the annotation request was received to reference the stored annotation information.” Nelson et al. and King et al. fail to teach or suggest at least this limitation.

As explained above, neither Nelson et al. nor King et al. teaches or suggests “modifying the index file that is “associated” with the stored media information “at the point at which the annotation request was received to reference the stored annotation information” as claimed. Thus, a *prima facie* case of obviousness has not been established for claims 16-20, and the 35 U.S.C. § 103(a) rejection should be withdrawn.

Reconsideration and allowance of pending claims 1-20 are respectfully requested.

In the event that any outstanding matters remain in this application, Applicants request that the Examiner contact Alan Pedersen-Giles at the number below to discuss such matters.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0221 and please credit any excess fees to such deposit account.

Respectfully submitted,

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